

Appl. No.: 10/717,173
Amendment dated November 16, 2005
Reply to Office Action of June 16, 2005
Page 6 of 10

REMARKS/ARGUMENTS

Reexamination and reconsideration of this Application, withdrawal of the rejections, and formal notification of the allowability of all claims as now presented are earnestly solicited in light of the above claim amendments and remarks that follow.

Claims 8-9, 16, 18, 22-23, 25, and 27 have been cancelled. Claims 1 and 19 have been amended to incorporate the subject matter of claims 9 and 23, respectively. Claim 6 has been amended to clarify the claim language thereof. Claims 10-12 and 24 have been amended to change their dependency in light of the cancellation of claim 9 and 23. New claims 31-37 have been added. Support for claim 31 can be found in previous claim 6. Support for claims 32-37 can be found at page 12 of the specification. Based on these amendments, claims 1-7, 10-15, 17, 19-21, 24, 26, 28-30, and 31-37 are pending in the present application. Claims 28-30 have been withdrawn by the Examiner; however, these claims remain in the above listing of claims pending the Examiner's decision on Applicant's traversal of the restriction requirement, discussed below.

Restriction Requirement

The Examiner previously restricted the claims of the invention and required election of either Group I (claims 1-27) or Group II (claims 28-30). In a telephone conversation with the Examiner on May 19, 2005, Applicant provisionally elected Group I. Applicant hereby affirms such election but specifically notes that such affirmation is made with traverse. In particular, Applicant respectfully submits it would not be an undue burden for the Examiner to search and examine both groups simultaneously. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the restriction requirement.

Rejections under 35 U.S.C. §112

Claim 6 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite for use of the phrase "such as." Claim 6 has been amended to remove the noted phrase, and Applicant submits the claim is now in proper form and should no longer be deemed indefinite. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection.

RTA01/2183770v1

Appl. No.: 10/717,173
Amendment dated November 16, 2005
Reply to Office Action of June 16, 2005
Page 7 of 10

Claims 16, 18, 25, and 27 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The rejected claims have now been cancelled. Accordingly, Applicant respectfully submits the rejection is obviated.

Rejection under 35 U.S.C. §101

Claims 16, 18, 25, and 27 stand rejected under 35 U.S.C. §101 as allegedly claiming a process without reciting any process steps. As noted above, the rejected claims have now been cancelled. Accordingly, Applicant respectfully submits this rejection is also obviated.

Rejection under 35 U.S.C. §102

Claims 1, 3-8, 13, 14, 17, 19-22, and 26 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,908,687. The Office generally argues the '687 patent discloses the recited subject matter of the noted claims. Applicant respectfully traverses the rejection and submits the rejections are not applicable to the presently amended claims.

Independent claim 1, as presently amended, recites a heat-sensitive stencil master comprising a heat-sensitive polymeric film having a thickness of less than 10 μm and, coated thereon, a solid foam comprising a cross-linked resin and a foaming agent. Furthermore, independent claim 19, as presently amended, recites a heat-sensitive stencil master comprising a heat-sensitive polymeric film and, coated thereon, a solid porous coating comprising a cross-linked resin and having a filler dispersed therein, wherein the filler is selected from the group consisting of carbon fibres, carbon particles and mixtures thereof.

The '687 patent fails to disclose, either expressly or inherently, a solid foam, or a solid porous coating, comprising a cross-linked resin. Further, the '687 provides no suggestion of the usefulness of a cross-linked resin in a heat-sensitive stencil master. Accordingly, Applicant respectfully submits the '687 patent fails to disclose or suggest each and every aspect of independent claims 1 and 19, and the '687 patent. Therefore, the '687 patent can not be viewed as anticipating claims 1 and 19, or the presently rejected claims depending therefrom. Applicant, therefore, respectfully requests reconsideration and withdrawal of the present rejection.

RTA01/2183770v1

Appl. No.: 10/717,173
Amendment dated November 16, 2005
Reply to Office Action of June 16, 2005
Page 8 of 10

Rejection under 35 U.S.C. §103

Claim 2 stands rejected under 35 U.S.C. §103(a) as being unpatentable over the '687 patent in view of U.S. Patent No. 4,082,887. Applicant respectfully traverses the rejection.

The Office primarily relies upon the '687 patent in the present rejection. Claim 2 depends from claim 1. As previously pointed out, the '687 patent fails to disclose or suggest each and every aspect of claim 1. Furthermore, the combination of the cited references fails to cure the previously noted defects of the '687 patent as a reference. As such, Applicant respectfully submits claim 2 can not be viewed as obvious over the combined references. Therefore, Applicant respectfully requests reconsideration and withdrawal of the present rejection.

Claims 9-12 and 23-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the '687 patent in view of U.S. Patent No. 4,260,703. Applicant respectfully traverses this rejection. Claim 9 has been cancelled; however, the subject matter thereof has been incorporated into independent claim 1. Accordingly, the following statements apply to the subject matter of claim 9 as incorporated into claim 1.

The Office argues the '687 patent teaches polyurethane and further argues it is obvious that polyurethane can be cross-linked. Applicant respectfully directs the attention of the Office to MPEP 2143.01, which states that the mere fact that references can be combined or modified does not lead to obviousness unless the prior art also suggests the desirability of the combination. Simply because polyurethane, or any other resin taught in the '687 patent, is capable of being cross-linked does not mean the '687 patent suggests cross-linking any of the resins disclosed therein. In fact, there is not such suggestion.

Examples 6A and 6B of the present application (the results of which are shown in Table 4 of the application) illustrate an increased degree of stiffness possible using the cross-linked resin according to the invention that has heretofore been unattainable in the art. While not wishing to belabor the point, the entire basis of the present rejection, and the combination of the cited references, is that it is allegedly obvious that polyurethane can be cross-linked. The mere

RTA01/2183770v1

Appl. No.: 10/717,173
Amendment dated November 16, 2005
Reply to Office Action of June 16, 2005
Page 9 of 10

statement that polyurethane can be cross-linked is insufficient to show motivation to alter the express teachings of the '687 patent, which is a non-cross-linked resin. Certainly nothing in the '687 patent suggests modification of any portion thereof that would lead to the improved results described above arising from the use of cross-linked resin.

Applicant further respectfully submits there is no suggestion or motivation in either the '687 patent or the '703 patent to combine the teachings thereof, and any such combination can only arise from the use of impermissible hindsight. Nothing can be pointed to in the '687 patent as expressly or inherently disclosing or suggesting the use of cross-linked resins. Furthermore, nothing can be pointed to in the '703 patent as providing suggestion or motivation to combine the teachings thereof with those of the '687 patent.

The '687 patent is directed to heat-sensitive stencils, and the '703 patent only provides a general disclosure relating to coatings comprising urethane-acrylate and radiation-curable compositions devised to overcome environmental problems associated with driving off solvent (see column 1, lines 6-32). There is nothing provided in the '703 patent that suggests the coating disclosed therein would act to improve a foamed resin or a stencil master derived therefrom. Rather, the only advantage set out in the '703 patent is a reduced detrimental effect on the environment. This can not be viewed as providing motivation to combine the references for the purpose of allegedly disclosing or suggesting the use of cross-linked resins in preparing a heat-sensitive stencil master. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the present rejection.

Claim 15 stands rejected under 35 U.S.C. §103(a) as being unpatentable over the '687 patent in view of U.S. Patent 3,804,700. Applicant respectfully traverses this rejection.

The Office primarily relies upon the '687 patent in the present rejection. Claim 15 depends from claim 1. As previously pointed out, the '687 patent fails to disclose or suggest each and every aspect of claim 1. Furthermore, the combination of the cited references fails to cure the previously noted defects of the '687 patent as a reference. As such, Applicant respectfully submits claim 15 can not be viewed as obvious over the combined references.

RTA01/2183770v1

Appl. No.: 10/717,173
Amendment dated November 16, 2005
Reply to Office Action of June 16, 2005
Page 10 of 10

Therefore, Applicant respectfully requests reconsideration and withdrawal of the present rejection.

In light of the foregoing, Applicants respectfully submit that the cited references are distinguishable from the claimed invention and request reconsideration and withdrawal of the rejections. It is believed that all pending claims are now in condition for immediate allowance. It is requested that the Examiner telephone the undersigned should the Examiner have any comments or suggestions in order to expedite examination of this case.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,


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CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the US Patent and Trademark Office at Fax No. (571) 273-8300 on the date shown below.


Rebecca Kerney

11/16/05
Date

RTA01/2183770v1